

SN 09/609,285
Page 14 of 25

REMARKS

This response is intended as a full and complete response to the final Office Action mailed on February 25, 2005. In the Office Action, the Examiner notes that claims 1-21, 27-49, 55-77, 83 and 84 are pending and rejected. By this response, Applicant has amended claims 1, 29 and 57. The amendments to the claims are fully supported by the Specification. For example, the amendments to the claims are supported at least by page 70, lines 21-23. Thus no new matter has been added and the Examiner is respectfully requested to enter the amendments.

In view of both the amendments presented above and the following discussion, the Applicant submits that all of the claims now pending in the application are non-obvious under 35 U.S.C. §103. Thus, the Applicant believes that all of these claims are now in allowable form.

It is to be understood that the Applicant, by amending the claims, does not acquiesce to the Examiner's characterizations of the art of record or to the Applicant's subject matter recited in the pending claims. Further, the Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive amendments.

REJECTIONS

35 U.S.C. §103

Claims 1-21, 27-49, 55-77, 83 and 84

The Examiner has rejected claims 1-21, 27-49, 55-77, 83 and 84 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner has rejected claims 1-21, 27-49, 55-77, 83 and 84 as being unpatentable over U.S. Patent 6,553,178-B2 to Abecassis (hereinafter "Abecassis") in view of U.S. Patent 5,754,938 to Herz (hereinafter "Herz"). Applicant respectfully traverses the rejection.

A. Claims 1-21, 29-49, and 57-77

The Applicant's independent claim 1 recites (emphasis added below):

"1. A method for automatically pausing a video program in response to an occurrence of an event, comprising:
receiving a video program;

367214_1.DOC

outputting the video program for presentation on a display device;
receiving an audio portion of a communications event;
detecting the receiving of the audio portion of the communications event during the video program presentation;
pausing the video program in response to the detection of the receiving of the audio portion of the communications event;
converting the audio portion of the communications event to corresponding text for display; and
outputting a signal for displaying an indication of the receiving of the audio portion of the communications event."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. *Jones v. Hardy*, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 496 (C.C.P.A. 1970), M.P.E.P. 2143.03. Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. *In re Wright*, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Abecassis and Herz references singly or in combination fail to teach or suggest the Applicant's invention as a whole.

Specifically, the Abecassis and Hertz references, singly or in combination, fail to teach or suggest at least the "pausing the video program in response to the detection of the receiving of the audio portion of the communications event" and the "converting the audio portion of the communications event to corresponding text for display" as recited in claim 1 as amended.

The Abecassis reference discloses an advertisement subsidized video-on-demand system in which, in relevant part, the user of the system may accept a communication during the use of the system and, in response to the acceptance of such communication, cause a video server transmission to be paused. Specifically, the Abecassis reference discloses (emphasis added below):

"A video and communication system for integrating the retrieval of a video and a communication comprises for example: i) retrieving means

SN 09/609,285
Page 16 of 25

for retrieving a video from a video provider or from a storing means storing said video; ii) communicating means for receiving a communication; iii) accepting means for accepting said communication; iv) terminating means for terminating said communication; v) pausing means, responsive to said accepting means, for automatically pausing said retrieving; vi) resuming means, responsive to said terminating means, for resuming said retrieving; vii) transmitting means, responsive to said retrieving means, for transmitting to a viewing system; and viii) preferencing means for establishing video content preferences." (column 51, lines 25-39)

Abecassis also discloses (emphasis added below):

"If the viewer accepts the call 1311, RAVIT initiates routines 1321-1323 to cause that the transmission of the video to the display is paused 1324. Viewer acceptance of the communication may include, for example, picking up a receiver, pressing a key on a remote control device, a voice command, or directly touching an icon on a screen either in a remote control device or on the display itself. Thus, a single viewer action or command 1311 both accepts the call and pauses the video 1324." (column 52, lines 18-27)

Thus, the pausing means of Abecassis is responsive to the accepting means, which accepts the communication received by the communicating means, and therefore only after acceptance is there any pausing of content. By contrast, the claimed invention pauses a video program in response to the detection of the receiving of an audio portion of a communications event.

Additionally, as the Examiner acknowledges, "Abecassis fails to disclose converting an audio portion of the communications event to text for display" (page 6 of the Office Action mailed on February 25, 2005).

Furthermore, the Herz reference does not bridge the substantial gap between the Abecassis reference and the Applicant's invention. Herz "relates to customized electronic identification of desirable objects, such as news articles, in an electronic media environment" (Abstract). However, the Herz reference also does not teach or suggest the "pausing the video program in response to the detection of the receiving of the audio portion of the communications event," as recited in claim 1, which is not taught by the Abecassis references.

Moreover, the Herz reference also does not teach or suggest the "converting the audio portion of the communications event to corresponding text for display," as recited in claim 1, which is not taught by the Abecassis reference. Specifically, Herz discloses (emphasis added below):

367214_1.DOC

SN 09/609,285
Page 17 of 25

"In addition to the news clipping service described above, the system for customized electronic identification of desirable objects functions in an e-mail environment in a similar but slightly different manner. The news clipping service selects and retrieves news information that would not otherwise reach its subscribers. But at the same time, large numbers of e-mail messages do reach users, having been generated and sent by humans or automatic programs. These users need an e-mail filter, which automatically processes the messages received. The necessary processing includes a determination of the action to be taken with each message, including, but not limited to: filing the message, notifying the user of receipt of a high priority message, automatically responding to a message. The e-mail filter system must not require too great an investment on the part of the user to learn and use, and the user must have confidence in the appropriateness of the actions automatically taken by the system. The same filter may be applied to voice mail messages or facsimile messages that have been converted into electronically stored text, whether automatically or at the user's request, via the use of well-known techniques for speech recognition or optical character recognition." (column 61, line 51 to column 62, line 6)

The Herz reference discloses applying an e-mail filter to voice mail messages that have been converted into electronically stored text via the use of well-known techniques for speech recognition or optical character recognition. Therefore, the Herz reference does not teach or suggest converting the voice mail messages into text, but instead discloses applying an e-mail filter to voice mail messages that have already been converted. By contrast, the claimed invention teaches converting the audio portion of the communications event. That is, the claimed invention actually converts the audio to text, instead of just performing processing of some text which has already been converted from audio.

Furthermore, the Herz reference does not teach or suggest that the voice mail messages have been converted for display. The Herz reference only discloses that the converted voice mail messages are processed by the e-mail filter, and that the processing can include filing the converted voice mail messages, notifying the user of the receipt of the converted voice mail messages, or automatically responding to the converted voice mail messages. Thus, the Herz reference does not teach or suggest that the voice mail has been converted for display. By contrast, the claimed invention teaches converting the audio portion of the communications event to corresponding text

367214_1.DOC

SN 09/609,285
Page 18 of 25

for display. For example, in one embodiment, the text created by converting the audio portion may be displayed on the display device.

Moreover, for prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

By alleging that the Applicants' invention is taught by a combination of Abecassis and Herz, the Examiner is using hindsight to pick and choose elements from the references to support his rejection. There is no motivation for combining Abecassis and Hertz in a manner that obviates the claimed invention. Abecassis is directed to a "content-on-demand architecture [which] provides for an elegant integration of the video and communication services that can be delivered to a viewer" (column 51, lines 15-17). Abecassis discloses (emphasis added below):

"In this example, the communications is a videophone call and is directed to the display 1304 at the time that RAViT is transmitting a video to the display 1301.

Directing the communications to the display first causes RAViT to provide an appropriate video and/or audio signal 1310 to the viewer through the display. The signal may include caller identification and other data relevant to or associated with the call.

If the viewer accepts the call 1311, RAViT initiates routines 1321-1323 to cause that the transmission of the video to the display is paused 1324. Viewer acceptance of the communication may include, for example, picking up a receiver, pressing a key on a remote control device, a voice command, or directly touching an icon on a screen either in a remote control device or on the display itself. Thus, a single viewer action or command 1311 both accepts the call and pauses the video 1324.

If the viewer does not accept the call during a predefined time, RAViT terminates the audio/video signal and engages communications recording function or devises to receive a message 1313. At the end of the message, RAViT hangs-up on the communication. In this case the video transmission to the display is not paused and RAViT video transmission continues uninterrupted." (column 52, lines 10-34)

367214_1.DOC

SN 09/609,285
Page 19 of 25

The Abecassis reference integrates video and communications to the extent that the communication, for example a videophone call, is always directed to the display and a video or audio signal is provided to the user through the display. If the view accepts the call, the video is paused, and if the viewer does not accept the call, the video or audio signal is terminated. However, in either case (acceptance or not acceptance of the call) the video or audio signal is provided to the viewer through the display.

By contrast, the Herz reference is directed to "a need for an information retrieval system that is largely or entirely passive, unobtrusive, undemanding of the user, and yet both precise and comprehensive in its ability to learn and truly represent the user's tastes and interests. Present information retrieval systems require the user to specify the desired information retrieval behavior through cumbersome interfaces." (column 2, lines 20-26) Thus, Hertz is concerned with an information retrieval system which is capable of dealing with a "plethora of information" (column 2, line 5), but which is passive and unobtrusive. Herz discloses a solution as recited below:

"The above-described problems are solved and a technical advance achieved in the field by the system for customized electronic identification of desirable objects in an electronic media environment, which system enables a user to access target objects of relevance and interest to the user without requiring the user to expend an excessive amount of time and energy. Profiles of the target objects are stored on electronic media and are accessible via a data communication network. In many applications, the target objects are informational in nature, and so may themselves be stored on electronic media and be accessible via a data communication network." (column 4, lines 35-41)

Thus, the Herz reference discloses it is desirable to be passive and unobtrusive and enable the user to access information without requiring the user to expend an excessive amount of time and energy. However, this is in direct contrast to the Abecassis reference, in which in all scenarios a communication causes a video or audio signal to be provided to the user through the display. Thus, there would be no motivation to combine Abecassis with Herz because they are directed to opposing goals. Herz is generally concerned with minimizing the amount of time and energy a user must expend, while Abecassis is directing every communication to the user and thus forcing the user to either accept or not accept the communication.

The combination of the Abecassis and Herz references fails to teach or suggest the Applicant's invention as a whole. Moreover, there is no motivation to combine the

367214_1.DOC

SN 09/609,285
Page 20 of 25

Abecassis and Herz references. As such, the Applicant submits that independent claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, independent claims 29 and 57 have substantially similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 29 and 57 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Additionally, claims 2-21, 30-49, and 58-77, depend directly or indirectly from independent claims 1, 29, and 57, and recite additional features thereof. As such, these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

B. Claims 27-28, 55-56, and 83-84

The Applicant's independent claim 27 recites (emphasis added below):

"27. A method for audio-to-text conversion of real-time telephone calls during viewing of a video program, comprising:
receiving a video program;
outputting the video program for presentation on a display device;
detecting occurrence of an incoming telephone call;
detecting an off-hook condition indicating answering of the telephone call;
converting an audio portion of the telephone call to corresponding text; and
displaying the corresponding text with the video program."

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 496 (C.C.P.A. 1970), M.P.E.P. 2143.03. The Abecassis and Herz references singly or in combination fail to teach or suggest the Applicant's invention as a whole.

367214_1.DOC

Specifically, the Abecassis and Hertz references, singly or in combination, fail to teach or suggest at least the "audio-to-text conversion of real-time telephone calls during viewing of a video program," the "converting an audio portion of the telephone call to corresponding text," and the "displaying the corresponding text with the video program" as recited in claim 27 as amended.

The Abecassis reference discloses an advertisement subsidized video-on-demand system in which, in relevant part, the user of the system may accept a communication during the use of the system and, in response to the acceptance of such communication, cause a video server transmission to be paused. The Abecassis reference further discloses that "[t]he 'communication' may be in the form of a conventional phone call, videophone call, fax, messaging and paging, and any analog or digital transmission" (column 51, lines 16-25). However, as the Examiner acknowledges, "Abecassis fails to disclose converting an audio portion of the communications event to text for display with the video program" (page 12 of the Office Action mailed on February 25, 2005). The Applicants respectfully submit that Abecassis also does not teach or suggest "audio-to-text conversion of real-time telephone calls during viewing of a video program" as recited in the claim.

Moreover, the Applicants respectfully submit that Abecassis also fails to teach or suggest "displaying the corresponding text with the video program" as recited in the claim. The Examiner alleges that "the video program and message may be displayed simultaneously (figure 14b)" (page 11 of the Office Action mailed on February 25, 2005). However, the Applicants respectfully disagree. Abecassis discloses (emphasis added below):

"FIG. 14B is an illustration of a display screen following viewer acceptance of the communication. Upon the pausing of the video, a last frame of the video image is reduced to an icon 1441. In the balance of the screen 1440, the videophone communication is displayed on a window 1451. Data 1452 associated with the communication is also displayed. In this example, the communication also comprises an integrated video transmission 1461 which is also displayed contemporaneously with the videophone transmission 1451." (column 54, lines 21-30)

Thus, Abecassis only discloses displaying a videophone communication, data associated with the communication, and an integrated video transmission.

Furthermore, in Figure 14B, it is shown that the data associated with the communication

is the name "JENN". Therefore, Abecassis does not disclose displaying text which is converted from an audio portion of the telephone call.

Furthermore, the Herz reference does not bridge the substantial gap between the Abecassis reference and the Applicant's invention. Herz "relates to customized electronic identification of desirable objects, such as news articles, in an electronic media environment" (Abstract). Specifically, Herz discloses (emphasis added below):

"In addition to the news clipping service described above, the system for customized electronic identification of desirable objects functions in an e-mail environment in a similar but slightly different manner. The news clipping service selects and retrieves news information that would not otherwise reach its subscribers. But at the same time, large numbers of e-mail messages do reach users, having been generated and sent by humans or automatic programs. These users need an e-mail filter, which automatically processes the messages received. The necessary processing includes a determination of the action to be taken with each message, including, but not limited to: filing the message, notifying the user of receipt of a high priority message, automatically responding to a message. The e-mail filter system must not require too great an investment on the part of the user to learn and use, and the user must have confidence in the appropriateness of the actions automatically taken by the system. The same filter may be applied to voice mail messages or facsimile messages that have been converted into electronically stored text, whether automatically or at the user's request, via the use of well-known techniques for speech recognition or optical character recognition." (column 61, line 51 to column 62, line 6)

Thus, Herz does not disclose the "converting an audio portion of the telephone call to corresponding text" and the "audio-to-text conversion of real-time telephone calls during viewing of a video program", as recited in the claim, which are not taught by Abecassis. Instead, Herz only discloses that voice mails have already been converted into text. Herz does not actually teach converting voice mails, but instead discloses applying an email filter to text which has already been converted from a voice mail. Furthermore, voice mails are not the same as telephone calls. For example, voice mails are inherently not real-time, but are instead pre-recorded. Converting a telephone call in real time is completely different from converting a pre-recorded voice mail.

Moreover, Hertz also does not disclose "displaying the corresponding text with the video program", as recited in the claim, which is not taught by the Abecassis

reference. Instead, Herz only discloses filing the converted voice mail message, notifying the user of the receipt of the converted voice mail message, and automatically responding to the converted voice mail message. None of these equate to displaying the converted text with the video program.

Furthermore, for prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

By alleging that the Applicants' invention is taught by a combination of Abecassis and Herz, the Examiner is clearly using hindsight to pick and choose elements from the references to support his rejection. There is no motivation for combining Abecassis and Herz in a manner that obviates the claimed invention. The Herz reference discloses it is desirable to be passive and unobtrusive and enable the user to access information without requiring the user to expend an excessive amount of time and energy.

However, this is in direct contrast to the Abecassis reference, in which in all scenarios a communication causes a video or audio signal to be provided to the user through the display. Thus, there would be no motivation to combine Abecassis with Herz because they are directed to opposing goals. Herz is generally concerned with minimizing the amount of time and energy a user must expend, while Abecassis is directing every communication to the user and thus forcing the user to either accept or not accept the communication.

The combination of the Abecassis and Herz references fails to teach or suggest the Applicant's invention as a whole. Moreover, there is no motivation to combine the Abecassis and Herz references. As such, the Applicant submits that independent claim 27 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, independent claims 55 and 83 have substantially

similar relevant limitations as those discussed above in regards to claim 1. Therefore, independent claims 55 and 83 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Additionally, claims 28, 56, and 84 depend directly or indirectly from independent claims 27, 55 and 83, and recite additional features thereof. As such, these dependent claims are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicant respectfully requests that the Examiner's rejection be withdrawn.

Official Notices

The Office Action takes numerous Official Notices. Applicant hereby traverses each Official Notice. See, for example, pages 7, 8, 9 (2 Notices), 10 (2 Notices) and 12 of the Office Action. The Examiner alleges that apparatus and/or methods taught by certain limitations are well known in the art. However, the Applicant believes that these apparatus and/or methods rejected by the Examiner using Official Notice may not be well known within the specific art of the present invention as recited in the pending claims. For example, the allegedly well known limitations may not be well known to be used in combination with other limitations of the claims in which they are found or in claims from which they depend.

SN 09/609,285
Page 25 of 25

CONCLUSION

Thus, the Applicant submits that all of the claims presently in the application are non-obvious under 35 U.S.C. §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 5/25/05

EJ Wall
Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808

367214_1.DOC